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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/661,159

Confirmation No.: 6784

Applicant(s): Vargas

Filing Date: 12 September 2003

Title: "Shape-Transferring Cannula System  
and Method of Use"

TC/Art Unit: 3736

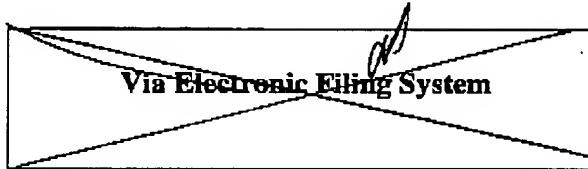
Examiner: Hoekstra, J.

Docket No.: ENDOV-001/US

**Petition**

Date: 23 March 2010

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



Via Electronic Filing System

Sir:

Applicant respectfully petitions to withdraw a holding of abandonment, because

Applicant failed to receive a Notice of Non-Compliant Amendment.

## I.

The United States Patent and Trademark Office (the "Office") allegedly mailed a Notice of Non-Compliant Amendment (the "Notice") for this application on 17 November 2009. It appears that this Notice was mailed in response to Applicant's amendment document filed on 7 October 2009. As the Notice appears in the Patent Information and Retrieval System, the

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Notice states that the amendment document was non-compliant because the claim status identifier "Amended" should instead be "Currently Amended".

## II.

In accordance with the information outlined in the Manual of Patent Examining Procedure (8th Ed. Rev. Jul. 2008), § 711.03(c), Applicant provides the following statements and information.

A. The system used to record Office actions at Intuitive Surgical, Inc. begins with the receipt of all mail addressed to the correspondence address of record associated with this application being delivered to a central mail room. There, the mail is sorted by recipient address within the company. Mail from the Office is placed in a mail receptacle for the legal department. At least once each day, a clerk in the legal department retrieves the mail from this receptacle. Mail from the Office is first opened and examined by employee Anne Killingsworth, who functions as the legal department's docketing clerk. If a paper from the Office indicates that a response is required by a particular deadline, Anne does two things. First, she retrieves the paper file associated with the particular application and clips the paper to the outside of the file. Second, she enters the due date in the legal department's computerized docketing system record associated with the particular application. For situations that require a response be filed within one month of the paper's mailing date, Anne's general practice is to call one of the legal department's patent attorney's immediate attention to the paper. Anne prepares action due lists for all deadlines entered into the legal department's computerized docketing system, and she provides these lists to the appropriate legal department attorney.

B. The legal department uses the computerized Dennemeyer Intellectual Asset Management System (DIAMS) version 8.04.09.4, provided by Dennemeyer & Co., to record due

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dates associated with papers received from the Office. This is a reliable system. Entry data for each patent application includes the Office's application number, the corresponding attorney docket number, and the due date for any response required by a paper received from the Office.

C. To the best of the undersigned attorney's information and belief, the Notice was not received at Intuitive Surgical, Inc. The undersigned attorney has searched the legal department mail receptacle in the mail room and the surrounding area (e.g., under the receptacle shelves in case the Notice had somehow fallen), the shelf area in which the paper record associated with this application is kept, and the contents the paper record associated with this application but was unable to find the Notice.

D. To the best of the undersigned attorney's information and belief, the legal department first learned that the Notice had been mailed when the legal department received a Notice of Abandonment that the Office appears to have mailed on 19 February 2010. Upon receipt of this Notice of Abandonment, Anne Killingsworth accessed the Office's Patent Application Information Retrieval system and was able to download a copy of the Notice of Non-Compliant Amendment.

E. To the best of the undersigned attorney's information and belief, the docketing system does not provide a "master docket for the firm" for a particular date range in any usable form. In lieu of such a "master docket", attached to this Petition as Exhibit 1 are (i) an image of the portion of the docketing system record that is associated with this application's identifying details, and (ii) two images that show the portion of the docketing system record that is associated with this application's due dates (completed and pending). These images indicate that the due date associated with the Notice was not entered into the legal department's docketing system, and they are submitted as further evidence that the Notice was not received. The images

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show that some portion of the record associated with this application was updated on 24 November 2009, but again, there is no evidence that any due date associated with the Notice was entered. After discussing this matter with Anne Killingsworth, the undersigned attorney was unable to determine what portion, if any, of this record was updated on 24 November 2009.

III.

Applicant respectfully petitions the Director under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment. Accordingly, Applicant believes that no petition fee is due.

If, however, the Office determines that this Petition is more correctly made under 37 C.F.R. § 1.137(a) or 1.137(b), then to speed handling of this Petition the Office is authorized to deduct from Deposit Account No. 503404 \$540.00 (for § 1.137(a)) or \$1620.00 (for § 1.137(b)) as may be necessary.

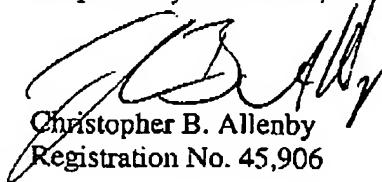
In addition, the Office is authorized to deduct from Deposit Account No. 503404 any additional fees that may be due to reopen prosecution of this application. Large entity fees apply.

IV.

Applicant includes with this Petition a corrected version of the amendment paper filed 7 October 2009. This corrected version includes the correct claim status identifiers for all claims.

Applicant respectfully requests the Director grant this petition. Please contact the undersigned attorney at 408-523-2460 if there are any questions.

Respectfully Submitted,

  
Christopher B. Allenby  
Registration No. 45,906

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## Exhibit 1

## Docket System Images

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

The screenshot shows the DIAMS Patent Management (View only) interface. The application number is 10/661,159. The patent title is "CANNULA SYSTEM & METHOD OF USE". The inventors listed are ALLENBY CHRISTOPHER and VARGAS JAIME S. The application date is 12-Sep-2003, and the grant date is 18-Mar-2004. The status is Pending. The priority date is 12-Sep-2002. The file status is Abandoned Date 06-Aug-2007, Last Annuity Paid, and Next Annuity Due. The form includes sections for Invention Disclosure, Prior Art, Names, Patent Details, Additional Info, Docs Link, and Docketing.

Invention Disclosure		Prior Art		Names		Patent Details		Additional Info		Docs Link		Docketing	
Country	United States of America	Convention	Pkt-Claimed	Type	Patent	Application No.	10/661,159	Application Date	12-Sep-2003	Grant No.	Grant Date		
Region		Origin		Sub Type									
Status	Pending	Independent Claims		Request Search Date		1st Publication No.	2004-0054322	1st Publication Date	18-Mar-2004	2nd Publication No.	2nd Publication Date		
Sub Status	Published	Dep.	Mult Dep.	Request Exam Date		2nd Publication No.		2nd Publication Date					
Claimed Priorities & Parent Records				File Status		Abandoned Date	06-Aug-2007	Expiration Date	12-Sep-2003				
Priority ENDOY001PROV/US 12-Sep-2002				File Ref		Last Annuity Paid		Next Annuity Due					
				Annuity Instructions		Calculate Expiration & Annuity Fees/Dates							
Record #	2/5	Created	15-Nov-2007 ANNEK	Updated	24-Nov-2009 ANNEK							22-Mar-2010	
Ready													

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This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

DIAMS

File Help Menu Reports Utilities Research Windows Help

DIAMS - Patent Management (View only)

Doctet ID 10661159	Short Title CARNIVAL SYSTEM & METHOD OF USE	Other Party
Client/Business Units:		Applicant/Prohibitor
Attorneys ALLENBY CHRISTOPHER	Scott Countries	
Inventors VARGAS JAIME S	Laboratories	
Related Matters:		

Invention | Disclosure | Disclosure 2 | Prior Art | Names | Patent Details | Additional Info | Docs Link | Docketing |

Phase	Subphase	From	To
<input checked="" type="radio"/> NYF	<input checked="" type="checkbox"/> Pending	<input checked="" type="checkbox"/> Events	<input checked="" type="checkbox"/> Date
<input type="radio"/> PGP	<input type="checkbox"/> Type	<input type="checkbox"/> Date	
<b>Actions Taken</b>			
Application Date	Entered/Refused	Date	Event
10/661,159	12-Sep-2003		15-Nov-2007
Paid: Filing	2004-005432	18-Mar-2004	20-Oct-2008
OAI Mail Date		17-Feb-2005	15-Nov-2007
Final QA Mail Date		01-Nov-2006	15-Nov-2007
ADVISOR OPINION		21-Feb-2007	15-Nov-2007
Abandoned Date		06-Aug-2007	15-Nov-2007
Restitution Requirement Mail Date		29-Oct-2008	04-Nov-2008
JDS VERT & ATTY		13-Nov-2008	17-Nov-2008
ITS Entry		12-Dec-2008	17-Dec-2008
end		29-Dec-2008	05-Dec-2008
OAI2 Mail Date		07-Apr-2009	09-Apr-2009
Expiration Date		12-Sep-2023	15-Nov-2007
OAI Response Date		17-May-2008	13-Aug-2008
Final Paid Date - 2 Months		01-Jun-2008	15-Nov-2007

Recalculation | New Sub-phase | Del Sub-phase

Record 1 / 2/5 Created: 15-Nov-2007 ANNEK Updated: 24-Nov-2009 ANNEK 22-Mar-2010

Ready

Exhibit 1 Page 2

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This is the second of two pages that show docket entries (due and completed) currently in the DIAMS system that are associated with this application.

The screenshot shows the DIAMS Patent Management (View-only) interface. At the top, there are tabs for Invention, Disclosure, Disclosure 2, Prior Art, Names, Patent Details, Additional Info, Docs Link, and Docketing. The Docketing tab is active. The main area displays a grid of docket entries with columns for Phase, Subphase, Date, and Description. A toolbar at the bottom provides options like Recalculate, New Sub-phase, and Del Sub-phase.

Phase	Subphase	Date	Description
Appn (1)		29-Dec-2008	05-Dec-2008
ext		07-Apr-2009	09-Apr-2009
OAI Mail Date		12-Sep-2003	15-Nov-2003
Expiration Date		17-May-2006 13-Aug-2006	12491 15-Nov-2007
OAI Response Date		01-Dec-2006	15-Nov-2007
Final Resp. Due - 1 Mo Retd		01-Jan-2007	15-Nov-2007
Final Resp. Due - 1 Mo Retd		01-Jan-2007 30-Jan-2007	12491 15-Nov-2007
Response to Previous Advisory Action		01-Feb-2007	15-Nov-2007
Final Response Date		01-Mar-2007	15-Nov-2007
Final Resp. Due - 1 Mo Ext		01-Apr-2007	15-Nov-2007
Final Resp. Due - 2 Mo Ext		01-May-2007	15-Nov-2007
Final Resp./Not. of Appeal Due - FINAL		29-Nov-2008 12-Nov-2008	12491 04-Nov-2009
Restriction Requirement Resp. Due		07-Jul-2009 07-Oct-2009	12491 09-Apr-2009
OAI Response Date			

\*\*\*\*\* Last Item \*\*\*\*\*

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